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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,900	11/25/2003	Charles L. Tazzia	IN-5653	1184

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/723,900

Applicant(s)

TAZZIA, CHARLES L.

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/16/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. Claims 2, 3, and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 2, the recitation of "about" in conjunction with the value of 50, renders the claims indefinite, because it cannot be determined exactly what values of n are encompassed by the language; therefore, it cannot be determined what compounds are defined by the structure.

Within claim 7, it is unclear what determines if the "salting" step is necessary. It is unclear to what extent the limitation is optional,

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-6, 11, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-10 of copending Application No. 10/723,899. Although the conflicting claims are not identical, they are not patentably distinct from each other because the curing agents of the copending application encompass uretdione compounds and the coatings encompass electrodepositable coatings.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 7, 8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Mosbach et al. ('983).

Patentees disclose an aqueous coating composition comprising a hydroxyl functional polyacrylate and a uretdione curing agent derived from hexamethylene diisocyanate. See Example 3.

6. Claims 1-4, 7, 8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahmed et al. ('460).

Patentees disclose an aqueous coating composition comprising an epoxy resin and a uretdione curing agent derived from isophorone diisocyanate. See Examples 1 and 2.

7. Claims 1-4, 7-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al. ('108).

Patentees disclose an aqueous powder paint dispersion comprising a polyester resin, an acrylic resin, and an epoxy resin and a uretdione curing agent derived from isophorone diisocyanate. See Preparation Example 1 (column 12, lines 25-30).

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8. Claims 1-9, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sapper et al. ('903).

Patentees disclose an aqueous powder coating dispersion comprising at least one binder and a room temperature solid isocyanate, such as a uretdione. Patentees further disclose that the coating may be applied by electrostatically assisted means. See abstract; column 3, lines 50+; column 7, lines 46-64; and column 11, lines 8-12.

9. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiori et al. (US 2001/0003755 A1).

The reference discloses aqueous coatings, suitable for use in electrodeposition applications, wherein acrylic coatings are combined with a polyisocyanate crosslinker. The reference further discloses uretdione derived from isophorone diisocyanate as a suitable crosslinker. See abstract and paragraphs [0037] and [0056]. The position is taken that it would have been obvious to one of ordinary skill in the art to select the uretdiones from the disclosed crosslinkers, as one would have reasonably expected the selection of virtually any of the disclosed crosslinkers to yield a viable coating composition.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
September 28, 2005

  
RABON SERGENT  
PRIMARY EXAMINER